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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,065	11/28/2001	Frank M. Zizzamia	098056/00120	1153

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KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
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NEW YORK, NY 10036

EXAMINER

RINES, ROBERT D

ART UNIT	PAPER NUMBER
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3623

NOTIFICATION DATE	DELIVERY MODE
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09/02/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

Office Action Summary	Application No. 09/996,065	Applicant(s) ZIZZAMIA ET AL.	
	Examiner R. David Rines	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009 and 15 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 8-12 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

[1] This communication is in response to the amendment filed 27 July 2009 and the response to the Requirement for Information under 37 C.F.R. § 1.105 filed 15 June 2010. Claims 1-3, 7-9, 12, 13-19 have been amended. Claims 1-20 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

[2] Previous rejection of claims 13-16 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter have been overcome by the amendment(s) to the subject claim(s) and are hereby withdrawn.

[3] Previous rejection of claims 8-12 and 17-20 under 35 U.S.C. 101 have not been overcome by the amendment(s) to the subject claims and are maintained herein.

Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. The latter three categories define "things" or "products" while a process consists of a series of steps or acts to be performed. For purposes of determining whether a process is eligible for patent under 35 U.S.C 101, a process has been given specialized, limited meaning by the courts.

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claims 8 and 17 are held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

In determining whether a process is directed to an abstract idea, a useful starting point to determine whether the inventive steps of the claimed process: (1) is/are tied to a particular machine or apparatus or (2) transform(s) underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010). If neither of these requirements is met by the claim, a determination that the claim is directed to an abstract idea can be reasonably made.

Claims 8 and 17 do not present a substrate or material such that element (2), the transformation of underlying subject matter, applies.

Claims 8 and 17 are directed to methods for insurance profitability scoring. The recited steps are limited to a series conceptual (computing, calculating, actions, mathematical) manipulations. The inventive steps of the method are not meaningfully tied to a particular machine or apparatus.

While Examiner recognizes that claims 8 and 17 each recite a displaying step and further recite the general involvement of a "system", it is not clear that the recited "system" denotes a particular machine tied to the inventive steps of the claimed method. further the mere acts of "populating a database associated with a system" and "displaying" an output constitute insignificant extra solution activity and accordingly, any machine implied by the noted recitations is not meaningfully tied to the inventive steps of the method.

Accordingly, claims 8 and 17 are rejected under 35 U.S.C. 101 as being directed to a non-statutory abstract idea.

Claims 9-12 and 18-20, by virtue of their dependence on claims 8 and 17, respectively, and when analyzed in the same manner described above with respect to claims 8 and 17, further fail to indicate that the claim(s) are not directed to an abstract idea. Specifically, claims 9-12 and 18-20 further define mathematical calculations but fail to provide specific indication of practical application of the calculations in the form of a substantive tie to a particular machine or apparatus. Therefore, claims 9-12 and 18-20 are also rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[4] Previous rejection of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over combinations of Summerell et al. (United States Patent #5,937,387), Tanaka (United States Patent Application Publication #2002/0133441) and Hammond et al. (United States Patent #5,613,072) have been overcome by the amendment(s) to the subject claims and are hereby withdrawn.

Allowable Subject Matter

[5] Claims 1-20 are allowable under 35 U.S.C. 102 and 35 U.S.C. 103.

REASONS FOR ALLOWANCE

[6] The following is an examiner's statement of reasons for allowance:

Claim 13

The prior art of record neither anticipates nor supports a conclusion of obviousness with respect to the allowable subject matter of claim 13.

Applicant's remarks filed 27 July 2009 and Applicant's *bona fide* response to the Requirement for Information under 37 C.F.R. § 1.105 filed 15 June 2010 are compelling and commensurate with both the original disclosure and the claims as amended. Claim 13 is allowable over the art of record for the reasons discussed in the noted responses.

Claims 1-12 and 14-20

Claims 1-12 and 14-20 are allowable over the prior art of record for reasons consistent with those identified with respect to claim 13.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. David Rines whose telephone number is (571)272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. David Rines/
Primary Examiner, Art Unit 3623